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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,423	12/28/2000	Ralf Rick	10191/1665	7857
26646	7590	02/07/2005	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			CHEN, SHIN HON	
			ART UNIT	PAPER NUMBER
			2131	

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/750,423	RICK, RALF	
	Examiner	Art Unit	
	Shin-Hon Chen	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 August 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12/28/03 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. Claims 1-15 have been examined.

Claim Rejections - 35 USC § 112

2. Claims 13-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Erasing the key in the computer and erasing the key in the dongle will render the invention inoperable.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1,4 ,5 and 8-10 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Larsson et al. U.S. Pat. No. 6226747 (hereinafter Larsson).

5. As per claims 1, Larsson discloses a device for preventing pirated copies of computer programs for use with a computer (Larsson: column 3 line 42 – column 4 line 38), comprising:

input and output device for bi-directional data exchange with the computer (Larsson: column 3 line 42 – column 4 line 38); a first memory element containing a data file that is transferable to the computer via the output device, the data file including a key (Larsson: column 5 lines 4-8: compare the identification information stored in the floppy disk with information stored on CD); and a second memory element into which data is writable by the input device (Larsson: column 9 lines 19-35: records computer identification information); wherein the first memory and second memory element are arranged on a memory (memory chip, floppies, storage devices) (Larsson: column 5 lines 23-47). Larsson does not explicitly disclose the data including a key and the first element and second element are arranged on a memory chip. However, Larsson discloses that dongle is well known in the art to prevent unauthorized execution of software and the dongle is used to provide software key so that the software can be executed (Larsson: column 2 lines 11-39: dongle or hardware key).

6. As per claim 4, Larsson discloses the device according to claim 1. Larsson further discloses wherein the input and output devices are adapted to a module port of the computer so that the input and output devices are insertable into the module port (Larsson: column 3 line 42 – column 4 line 37: inserting the floppy disk). Floppy disk provides input/output function and uses input/output port of a computer to read/write data to a computer.

7. As per claim 5, Larsson discloses a method of preventing pirated copies of computer programs (Larsson: column 3 line 42 – column 4 line 38), comprising the steps of: connecting a device to a computer for bi-directional data exchange (Larsson: column 3 line 42 – column 4 line

38), the device including input and output devices and first and second memory elements (Larsson: column 5 lines 4-8 and column 8 lines 20-31: reading license information for verification; column 9 lines 19-34: writing computer identification information to memory); transferring a first data file containing a key from the first memory element of the device to the computer (Larsson: column 8 lines 20-49); and copying a second data file containing an identifier from the computer to the second memory element of the device (Larsson: column 9 lines 19-33).

8. As per claim 8, Larsson discloses a data carrier storing a computer program (Larsson: column 3 line 42 – column 4 line 38), the computer program being executable by entering the data carrier into a computer (Larsson: column 3 line 42 – column 4 line 38), the data carrier containing a key and an identifier (Larsson: column 8 lines 20-49 and column 9 lines 5-33), the computer program, upon execution, carrying out the following steps: transferring a first data file containing the key from a first memory element of a device to the computer (Larsson: column 5 lines 4-8 and column 8 lines 20-49), the device further including input and output devices (Larsson: column 8 lines 20-49 and column 9 lines 5-33); and copying a second data file containing the identifier from the computer to a second memory element of the device (Larsson: column 9 lines 5-33).

9. As per claim 9, Larsson discloses the device of claim 1. Larsson further discloses the key includes an electronic key (Larsson: column 8 lines 20-31: electronic data including serial number and identifiers).

10. As per claim 10, Larsson discloses the device of claim 1. Larsson further discloses the data file is transferable to the computer so that the data file is stored on the computer (Larsson: column 3 lines 53-62).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larsson in view of Pavlin et al. U.S. Pat. No. 6523119 (hereinafter Pavlin).

13. As per claim 2, Larsson discloses the device according to claim 1. Larsson does not explicitly disclose wherein memory chip includes a ROM memory chip. However, Pavlin discloses dongle/hardware key includes memory chip (Pavlin: column 4 line 66 – column 5 line 15). It is well known in the art to include memory chips in dongle/hardware keys which are used to protect software from illicitly used. Pavlin reference discloses read only memory chips such as EEPROM. However, it would have been obvious to one having ordinary skill in the art to change the memory chip disclosed by Pavlin to read/write memory chip to allow dynamic read/write function as supported by floppy disks and the floppy disk information disclosed by Larsson is stored in read-only area while the computer identification information is to be inputted into

writable area of a memory chip because different memory devices can be used to carry out the functions of dongles/license floppies. Therefore, it would have been obvious to one having ordinary skill in the art to combine the teachings of Pavlin within the system of Larsson because it is well known in the art to use different types of memory to perform security processes and it does not reduce the performance of the system. Alternatively, Larsson also discloses that other types of memory can be implemented (Larsson: column 5 lines 23-28).

14. As per claim 3, Larsson as modified discloses the device according to claim 2. Larsson as modified further discloses wherein the memory chip is a nonvolatile semiconductor memory (Pavlin: column 4 line 66 – column 5 line 15). Same rationale applies here as above in rejecting claim 2.

15. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larsson in Kupka U.S. Pat. No. 6434535 (hereinafter Kupka) and further in view of Mullor et al. U.S. Pat. No. 6411941 (hereinafter Mullor).

16. As per claim 6, Larsson discloses the method according to claim 5. Larsson does not explicitly disclose the method further comprising the step of entering into the computer an enable number encoded with the key. However, Kupka further discloses entering license information into the computer for verification (Kupka: column 1 lines 35-57). It would have been obvious to one having ordinary skill in the art to prompt users to enter license information for comparison is

Art Unit: 2131

well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art to combine the teachings of Kupka within the system of Larsson.

Larsson as modified does not explicitly disclose entering encoded enable number encoded by key stored in the memory. However, Mullor discloses comparing decrypted license information stored in the computer (Mullor column 6 lines 28-39). It would have been obvious to one having ordinary skill in the art to modify the Larsson reference to store key for decrypting encrypted license information, which is well known in the art, and modify the Kupka reference by entering encrypted license information that can be decrypted using the key provided in the memory and then compare the result. Therefore, it would have been an obvious matter of design choice to modify the references to enter encrypted license information into computer and decrypt it using key stored in memory device since the applicant does not explicitly disclose entering encrypted license information and then decrypt it using key stored in the memory solves any stated problem or is for any particular purpose and it appears that comparing license information stored in the memory with the license information stored in the software would perform equally well for verification.

17. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larsson.

18. As per claim 7, Larsson discloses the method according to claim 5. Larsson does not explicitly disclose the step of transferring the key from the computer back to the connected device after checking the identifier. However, Larsson discloses uninstalling/removing the software from the computer in order to install on another computer and removing the computer

identification from the file (Larsson: column 10 line 36 – column 11 lines 29). It would have been an obvious matter of design choice to modify the Larsson reference to transfer the key back from the computer back to the connected device after checking the identifier since the applicant does not disclose transferring the key back solves any stated problem or is for any particular purpose and it appears that uninstalling the software from the computer would perform equally well.

19. Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larsson in view of Comerford et al. U.S. Pat. No. 5109413 (hereinafter Comerford).

20. As per claim 11 and 12, Larsson discloses the device of claim 1. Larsson does not explicitly disclose the data file is transferable to the computer so that the data file is removed from the device and stored in the computer. However, Comerford discloses transferring the right to execute from one coprocessor to another (Comerford: column 7 lines 26-41: erase the software key; column 17 lines 31-57: the coprocessor and the key stored within the coprocessor; figure 1 item 20). It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to use the coprocessor as the dongle because the coprocessor and the dongle are used to prevent unauthorized software execution. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Comerford within the system of Larsson because it reduces the opportunity for improperly multiplying rights to execute.

21. As per claim 13-15, claims 13-15 encompass the same scope as claim 12. Therefore, claims 13-15 are rejected based on the reason set forth in claim 12.

Response to Arguments

22. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

The Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6550011 discloses media content protection and deleting content key after it has been transmitted (column 15 lines 6-21).

U.S. Pub. No. 20010011254 discloses distributed execution software license server.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 2131

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shin-Hon Chen whose telephone number is (571) 272-3789. The examiner can normally be reached on Monday through Friday 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shin-Hon Chen
Examiner
Art Unit 2131

SC

*Eugene J. Lamarre
Primary Examiner*